

**REMARKS**

Claims 1-19 remain pending in the present application upon entry of this amendment/response. Claims 1, 10, and 11 have each been amended to more clearly recite the type of elastomeric layer that is being claimed. Support for these amendments may be found in the claims as originally filed. Claims 12-19 have been amended to correct multiple dependencies present in each claim. Support for these amendments may also be found in the claims as originally filed. No new subject matter, however, has been added.

**Invention Synopsis**

The present invention relates to an elastic laminate which is elastically extensible in at least one direction. The elastic laminate includes an elastomeric layer a first surface and a second surface opposing the first surface and wherein the elastomeric layer is in a form selected from the group consisting of a scrim, an apertures formed film, an elastomeric woven or nonwoven, discrete strands and strings; and a first nonwoven layer joined to the first surface of the elastomeric material. The first nonwoven layer is formed from component fibers having a primary fiber direction. The first nonwoven layer has a Fiber Orientation Ratio within about  $\pm 20$  degrees from a primary fiber direction of at least about 65%. The present invention is also directed to a disposable garment employing such an elastic laminate.

**Rejection Under §103**

Claims 1-8 and 10-19 have been rejected under 35 USC §103 as being unpatentable over Van Gompel et al. (USP 4940464) in view of Masahiko (JP Publication 03-158236). The Office reasons that Van Gompel discloses a disposable pant-like garment for absorbing human discharge and comprises an absorbent assembly comprising a liquid-impervious outer cover, liquid pervious liner and an absorbent core contained there between. The Office additionally mentions that the disclosed garment includes side panels that are stretchable and that can be made of stretch bonded laminate, which generally comprises an elastic layer disposed between two nonwoven layers. Although the Office notes that Van Gompel fails to teach that the nonwoven layers have preferred fiber orientation, it relies on Masahiko as teaching a laminate having a thermoplastic rubber layer and a nonwoven layer having fibers, such as polypropylene or polyester arranged longitudinally in parallel or zigzag direction. Consequently, the Office contends that it would have been obvious for one of ordinary skill in the art to optimize the disclosures to arrive at the claimed values. Applicants respectfully traverse this rejection.

Van Gompel clearly relates to the subject matter discussed above. The reference, however, clearly fails to teach or suggest a laminate that includes an elastomeric layer that is in a form selected from the group consisting of a scrim, an apertures formed film, an elastomeric woven or nonwoven, discrete strands and strings. Furthermore, Applicants find no teaching in the reference of a laminate that additionally includes a first nonwoven layer which has a Fiber Orientation Ratio within about  $\pm 20$  degrees from a primary fiber direction of at least about 65%. Based on

these failed teachings, Applicants respectfully submit that there is no way that a skilled artisan would have arrived at the present invention based on this disclosure.

Masahiko discloses a laminate as described above. Masahiko does not, however, teach or suggest a laminate that includes an elastomeric layer that is in a form selected from the group consisting of a scrim, an apertures formed film, an elastomeric woven or nonwoven, discrete strands and strings. Additionally, the reference fails to teach or suggest a first nonwoven layer which has a Fiber Orientation Ratio within about  $\pm 20$  degrees from a primary fiber direction of at least about 65%, as is presently claimed. Even though the reference discloses arranging the fibers longitudinally in parallel or a zigzag direction, there is no teaching or suggestion of the requisite amount of fibers that are to be arranged in the primary fiber direction and to what degree they are arranged within the desired range of orientation. Applicants have surprisingly found that these claimed limitations are key to providing an elastic laminate in which the elastic "stretchiness" is not decreased.

Assuming arguendo, even if one skilled in the art were to combine the respective disclosures of the cited references, he/she would still not arrive at the present invention for a lack of the abovedescribed limitations in the combination. For instance, the combination would lack a first nonwoven layer which has a Fiber Orientation Ratio within about  $\pm 20$  degrees from a primary fiber direction of at least about 65% as well as an elastomeric layer that is in a form selected from the group consisting of a scrim, an apertures formed film, an elastomeric woven or nonwoven, discrete strands and strings. In the absence of these teachings, there is no way one skilled in the art could have arrived at the present invention by combining Van Gompel and Masahiko. Applicants, therefore, submit that the rejection of claims 1-8 and 10-19 as being unpatentable under §103(a) over Van Gompel in view of Masahiko is improper. Accordingly, withdrawal of the rejection and reconsideration of the claims is respectfully requested.

Claim 9 has been rejected under 35 USC §103 as being unpatentable over Van Gompel et al. (USP 4940464) in view of Masahiko (JP Publication 03-158236) in view of Dean et al. (USP 6231976). The Office states that Van Gompel and Masahiko fail to teach that the fibers in the non-elastic nonwoven are bicomponent fibers. Therefore, the Office looks to Dean as teaching that bicomponent binder fibers can be used to make nonwovens to eliminate the need for a separate adhesive. Thus, the Office believes that it would have been obvious for one of ordinary skill to have used bicomponent binder fibers to make the non-elastic nonwoven since a skilled artisan would have been motivated by the desire to reduce the amount of time used to make the non-elastic nonwoven. Applicants traverse this rejection, too.

Dean relates to fibers, particularly binder fibers, made from copolyesters and copolyesters themselves, which are generally formed from a glycol component containing 1,3- or 1,4- cyclohexanedimethanol and ethylene glycol and at least one dicarboxylic acid component. Despite this disclosure of binder fibers, Dean likewise fails to

teach or suggest the each and every one of the limitations of the presently claimed invention. For instance, Applicants find no teaching or suggestion in the reference of laminate that includes an elastomeric layer that is in a form selected from the group consisting of a scrim, an apertures formed film, an elastomeric woven or nonwoven, discrete strands and strings or of a laminate that includes a first nonwoven layer which has a Fiber Orientation Ratio within about  $\pm 20$  degrees from a primary fiber direction of at least about 65%. Without these teachings, it is highly unlikely that one skilled in the art would have even ventured to arrive at the present invention.

Furthermore, assuming arguendo, even if a skilled artisan were to combine the disclosures of Van Gompel, Masahiko, and Dean, the resultant combination would still not permit one to arrive at the present invention. In particular, each of the three references fails to teach or suggest the specific elastomeric layers and fiber orientation ratio characteristics that are claimed by Applicants. Thus, the present invention would not have been rendered obvious in view of this combination of references. Applicants, therefore, request that the rejection under  $\S 103(a)$  over Van Gompel, Masahiko, and Dean be withdrawn as improper. Additionally, reconsideration is requested.

With regard to the Office's contention that those properties that are claimed by Applicants are also inherently possessed by the subject matter of the cited references, Applicants beg to differ. It is commonly held that a retrospective view of inherency is not a substitute for some teaching or suggestion which supports the selection and use of the various elements in the particular claimed combination. That which may be inherent is not necessarily known. Obviousness cannot be predicated on what is unknown. In re Newell, 891 F.2d 899, 13 USPQ2d 1248 (Fed. Cir. 1989). Since the cited references fail, individually and collectively, to make the public aware of the limitations that Applicants have found to be key to the present invention, it cannot be validly asserted that such properties are inherent in their disclosures.

Moreover, it is well settled that the Examiner cannot pick and choose among individual elements of assorted prior art references to recreate the claimed invention based on the hindsight of the Applicants' invention. Rather, the Examiner has the burden to show some teaching or suggestion in the references to support their use in the particular claimed combination. See SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 USPQ2d 1468, 1475 (Fed. Cir. 1985). Additionally, the mere fact that it is possible to find isolated disclosures which might be combined in such a way as to produce a new composition does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination. In re Grabiak, 222 USPQ2d 870, 872 (Fed. Cir. 1985). In the present instance, the "something" is missing. In fact, a few "somethings" are missing. Furthermore, "obvious to try" is not a valid test of patentability. In re Dow Chemical Co., 5 PQ2d 1529 (CAFC 1988); In re Antonie, 195 USPQ 6 (CCPA 1977). There must be a suggestion or teaching that the claimed novel form could or should be prepared. In re Coler, 148 USPQ 268 (CCPA 1966). These cited references, alone and in combination, fail to offer the requisite teaching or suggestion of each of the elements Applicants have claimed

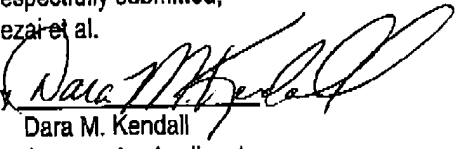
as key to the invention. Thus, Applicants assert that the rejections of obviousness based on the cited references are unfounded.

### CONCLUSION

Based on the foregoing statements, Applicants respectfully submit the issue raised by the Office have been addressed in a satisfactory manner. Reconsideration and withdrawal of the rejection is respectfully requested. Allowance of each of the pending claims in the next Office Action is earnestly requested as well.

Respectfully submitted,  
Rezai et al.

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